

PATENT
Atty. Dkt. No. ROC920000014US1
MPS Ref. No.: IBM2K0014

REMARKS

This is intended as a full and complete response to the Office Action dated September 28, 2004, having a shortened statutory period for response set to expire on December 28, 2004. Please reconsider the claims pending in the application for reasons discussed below.

Claims 3-4, 6-9, 12, 13, 15-18, 21, 22 and 24-33 are pending in the application. Claims 3-4, 6-9, 12, 13, 15-18, 21, 22 and 24-33 remain pending following entry of this response. Claims 3, 4, 12, 13, 15, 17, 21, 22, 24, 26 and 29-33 have been amended. Applicants submit that the amendments do not introduce new matter.

Claim Rejections - 35 USC § 103

Claims 3-4, 12-13, 21-22 and 28-33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Travis* (U.S. Patent No. 5,604,897) in view of *Fein et al.* (U.S. Patent No. 5,940,847, hereinafter Fein).

As presented in MPEP §2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants traverse the rejection on grounds that the Examiner has not properly established a *prima facie* obviousness rejection because the cited references fail to teach or suggest all the claim limitations. *Travis* discloses a method and system for correcting misspelled words in a word processing document utilizing a dictionary file and a corrected before file. (Col. 2, Lns. 56-58). The corrected before file, which may be updated by the user, contains a list of misspelled words and the associated correctly spelled words. (Col. 2, Lns. 65-67). The *Travis* spell checker program checks each word of the document against a list of words in the dictionary file to determine whether

PATENT
Atty. Dkt. No. ROC920000014US1
MPS Ref. No.: IBM2K0014

the respective word is misspelled and checks each misspelled word against a list of misspelled words in the corrected before file. (Col. 3, Lns. 27-50). *Fein et al.*, as discussed in the previous response, discloses a system and method for automatically correcting multi-word data entry errors.

The cited references, alone or in combination, fail to teach, show or suggest the steps for identifying problem words in a document as claimed in independent claims 3, 12, and 21, i.e., recording the pre-edited contents and the post-edited contents of the document and then comparing the pre-edited contents to the post-edited contents to identify the problem words and replacement words. The references cited by the examiner determine misspelled words or phrases by comparison against a dictionary and corrected before file (in *Travis*) or a substitution list (in *Fein*). Thus, the cited references, alone or in combination, fail to teach, show or suggest the method for providing user-specific error analysis as recited in the independent claims. Therefore, Applicants submit that the independent claims 3, 12 and 21, as well as those depending therefrom, are patentable over *Travis* in view of *Fein*. Withdrawal of the rejection is respectfully requested.

Claims 6-7, 15-16 and 24-25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Travis* in view of *Fein*, and further in view of *Grover et al.* (U.S. Patent No. 5,818,437, hereinafter *Grover*). As discussed above, the cited references, alone or in combination, fail to teach, show or suggest recording the pre-edited contents and the post-edited contents of the document and then comparing the pre-edited contents to the post-edited contents to identify the problem words and replacement words. Therefore, Applicants submit that claims 6-7, 15-16 and 24-25 are patentable over *Travis* in view of *Fein*, and further in view of *Grover*. Withdrawal of the rejection is respectfully requested.

Claims 8-9, 17-18 and 26-27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Travis* in view of *Fein*, and further in view of *Cai et al.* (U.S. Patent No. 6,175,834, hereinafter *Cai*). As discussed above, the cited references, alone or in combination, fail to teach, show or suggest recording the pre-edited contents and the post-edited contents of the document and then comparing the pre-edited contents to the post-edited contents to identify the problem words and replacement words. Therefore,

Page 9

326905_1

PATENT
Atty. Dkt. No. ROC920000014US1
MPS Ref. No.: IBM2K0014

Applicants submit that claims 8-9, 17-18 and 26-27 are patentable over *Travis* in view of *Fein*, and further in view of *Cai*. Withdrawal of the rejection is respectfully requested.

Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully requests that the claims be allowed.

Respectfully submitted,



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Page 10

326905_1